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AUG 11 2004

OFFICE OF PETITIONS

In re Application of :
Marty Pierre, Rey Gaelle, and Pascal :
Chauvet :
Application No. 10/700,361 : DECISION ON PETITION
Filed: November 3, 2003 :
Attorney Docket No. S1022.80985US01 :
Title: DRAM CONTROL CIRCUIT :

This is in response to the petition under 37 C.F.R. §1.47(a)¹, filed June 23, 2004.

On November 3, 2003, the application was deposited, identifying Marty Pierre, Rey Gaelle, and Pascal Chauvet as joint inventors. The application was deposited without an oath or declaration. On February 12, 2004, the Office mailed a Notice to File Missing Parts of Nonprovisional Application (Notice), requiring an executed oath or declaration along with the surcharge associated with the late filing of an oath or declaration, and the basic filing fee. The notice set a two-month period for response. On June 28, 2004, a notice was mailed which withdrew this notice.

¹A grantable petition under 37 C.F.R. §1.47(a) requires:

- (1) the petition fee of \$130;
- (2) a surcharge of either \$65 or \$130 if the petition is not filed at the time of filing the application, as set forth in 37 CFR § 1.16(e);
- (3) a statement of the last known address of the non-signing inventors;
- (4) either
 - a) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review and proof that the non-signing inventor refuses to join in the application or
 - b) proof that the non-signing inventor cannot be found or reached after diligent effort;
- (5) a declaration which complies with 37 CFR §1.63.

On June 23, 2004, petitioner submitted a copy of the declaration², the instant petition, a declaration of facts, the petition fee, the associated surcharge, the last known address of the non-signing inventor, and a copy of the assignment along with a translation. Petitioner has also included a two-month extension of time.

As such, Petitioner has met requirements (1) – (3) above.

Regarding the fourth requirement above, Petitioner has asserted that on September 19, 2002 and June 14, 2004, correspondence was sent to the non-signing inventor. Petitioner has characterized these mailings as constituting a “diligent effort...to locate Mrs. Rey³. ”

The Office disagrees. No mention is made as to any search done for the non-signing inventor. One cannot successfully assert that a diligent effort has been undertaken to locate the non-signing inventor if one has made no effort to locate the same, since one cannot claim that a diligent search was conducted if no search was performed. Petitioner has not given any indication that any effort has been made to locate the non-signing inventor. If Petitioner wishes to assert that the non-signing inventor cannot be located, he must perform a search before he may claim that the inventor cannot be found, as merely sending letters does not constitute a diligent search.

If future attempts to obtain a forwarding address or to locate the non-signing inventor by other means such as through E-mail, telephone, or the Internet fail, then applicant will have provided the necessary proof required under 37 C.F.R. §1.47 that the inventor cannot be reached. Details of the efforts to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person with first hand knowledge of the details.

Applicant should submit documentary evidence such as the results of an E-mail or Internet search. It is important that the statement contain facts as opposed to conclusions⁴.

Regarding the fifth requirement above, the declaration does not comply with MPEP §602.05(a). This section of the MPEP sets forth that a copy of the oath or declaration from a prior nonprovisional application may be filed in a continuation application. However, if this oath or declaration is submitted subsequent to the filing of the child: the cover letter accompanying the declaration should identify the application number of the continuation application; the cover letter should indicate that the declaration submitted is a copy of the declaration from a prior application, and; applicant should label the copy of the declaration with the application number of the continuation application.

² The declaration submitted with the instant petition is actually that which was associated with the grandparent of the instant application, 10/111,506, which was executed by each of the joint inventors save joint inventor Rey.

³ Petition, page 1.

⁴ See MPEP 409.03(d).

It does not appear that a cover letter has been included with the declaration which has been submitted with this petition, and the declaration does not contain the serial number of the instant application. As such, the declaration will not be accepted.

For these reasons, the petition under 37 C.F.R. §1.47(b) is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Renewed Petition Under 37 C.F.R. §1.47(a)," and should only address the deficiencies noted above, except that the reply may include an acceptable oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. §1.136(a).

Petitioner is reminded that all submitted statements should be from one having firsthand knowledge of the search.

The reply to this letter may be submitted by mail⁵, hand-delivery⁶, or facsimile⁷.

The reply should display "Please deliver to Paul Shanoski, c/o Office of Petitions" in a prominent manner. The Petitioner may wish to consider telephoning the undersigned at the number provided below to confirm that the documents were delivered to the undersigned. Please note that the delivery process can take as much as three weeks.

The application file will be retained in the Office of Petitions for two (2) months.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-0011. Please note that on approximately September 28, 2004, the Office of Petitions will relocate to the new PTO location in Alexandria. Although the mailing address will remain the same, the general phone number for the Office of Petitions which should be used for status requests will change to 571-272-3282, and the telephone number for the undersigned will change to 571-272-3225.



**Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office**

5 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

6 Customer Window, Mail Stop Petition, Crystal Plaza Two, Lobby, Room 1B03, Arlington, Virginia 22202.

7 (703) 872-9306 - please note this is a central facsimile number, and as such, there will be a delay in the delivery of the facsimile to the undersigned.